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Edward M. Weisz, Esq.
Cohen, Pontani, Lieberman & Pavane
Suite 1210
551 Fifth Avenue
New York, NY 10176

EXAMINER

LEZAK, ARRIENNE M

| ART UNIT | PAPER NUMBER |
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2143

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application

09/747,220

Applicant(s)

SEGAN ET AL.

Examiner

Arrienne M. Lezak

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☒ Claim(s) 44 is/are objected to.
- 8) ☒ Claim(s) 1-54 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>4/23/01</u> (4) | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Per telephone conversation with Counsel for Applicant on 25 March 2004, Examiner submits the following written restriction requirement after verbal enumeration of the same.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-45, drawn to recording a message, classified in class 709, subclass 225.
 - II. Claims 46-54, drawn to presenting a message, classified in class 709, subclass 227 or 232.
3. The inventions are distinct, each from the other because a method of providing a user incentive on a network does not rely upon or require a method for peer-to-peer communications and visa-versa.
4. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because a method of providing a user incentive on a network does not rely upon or require a method for peer-to-peer communications and visa-versa. The subcombination has separate utility such as a method for peer-to-peer information collaboration generally.

5. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

6. As noted above, a telephone call was made to Edward M. Weisz, Counsel for Applicant, on 25 March 2004, to request an oral election to the above restriction requirement. After consultation with Applicant, Attorney Weisz contacted Examiner to elect Group I for examination. Group II will not be examined as part of this Office Action.

Claim Objections

7. Examiner notes a discrepancy in the numbering of claims as Applicant has failed to include Claim 44. It is assumed that the claims as submitted herein represent Applicant's complete invention as examined, (after election), and the missing Claim is noted to be a non-substantive numbering error.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chelliah in view of "Frequently Asked Questions: Basic Information about MUDs and MUDding", Jennifer Smith and Andrew Cowan, 1996-1999.

10. Regarding Claims 1, 17, 26-28, 33 and 39, Chelliah discloses a system and method for providing incentive for a user of said system to access content over a network (Internet – pending Claim 26), (Abstract; Col. 11, lines 4-10; Col. 15, lines 6-23; Col. 20, lines 28-33; Col. 28, lines 52-67; and Col. 29, lines 1-23), comprising:

- a user node responsive to a browser program for providing communication between a user and said network, said user node being in communication with a user interface device for depicting a character icon to the user, Col. 28, lines 52-60);
- a subscriber advertiser node for providing connection of content to said user device on said network, (Col. 28, lines 52-67 and Col. 29, lines 1-23);
- a service provider server in communication with the user node and the subscriber advertiser node for communicating a command, (Col. 29, lines 3-23);
- wherein said command originates at said service provider server, (per pending Claim 27), (Col. 28, lines 52-67 and Col. 29, lines 1-23); and
- wherein said step of establishing a network connection further comprises the step of establishing a disk and execution monitor (DAEMON) connection between the user interface and the service provider, (per pending Claim 28), (Col. 28, lines 52-67 and Col. 29, lines 1-23).

11. Chelliah does not specifically teach the use of character icons with enhancement (and enhancement authorization) capabilities wherein the communication of a command effectuates a function on the user interface device pertaining to the character icon.

12. Smith and Cowan teach a MUD (Multiple User Dimension/Dungeon/Dialogue) which is a computer program that allows a user to take control of a computerized character capable of walking, chatting, exploring, solving puzzles and creating rooms, descriptions and items, (§ 1.1). Some MUDs require registration wherein a user must obtain a character from a MUD administrator, (§ 1.3), and others allow a user to create their own character, (§ 1.7), wherein moving and interacting with other characters is done through common commands, (§ 1.14).

13. To combine the MUD environment and functionalities with the Chelliah computer system and method for electronic commerce would have been obvious to one of ordinary skill in the art at the time of invention by Applicant. The motivation to combine, found within Chelliah, is the need to accommodate marketing activities necessary for customer generation within the e-commerce environment, (Col. 1, lines 63-67 and Col. 2, lines 1-3). Examiner notes that within some interactive Internet MUD environments, users are rewarded with "electronic monies" which allow users to purchase items, powers, etc. As a MUD environment allows for commercial functionalities, the incorporation of MUD characters into a system, (like Chelliah), which already teaches marketing-need-based e-commerce incentive programs, (coupon-based, frequent buyer, quantity discount and in-store), would have been obvious and as such is unpatentable. Thus, Claims 1, 17, 26-28, 33 and 39 are found to be unpatentable over

the combined teachings of Chelliah in view of MUD-based functionalities, (as taught by Smith and Cowan).

14. Regarding Claim 2, Chelliah, Smith and Cowan are relied upon for those teachings enumerated herein. As noted above, Chelliah teaches a service provider capable of providing incentive program objects, however, Chelliah does not incorporate interactive character icons into the system. Smith and Cowan teach a MUD-based character whose incorporation into the Chelliah system and method would have been obvious as noted herein above. Thus, Claim 2 is found to be unpatentable over the combined teachings of Chelliah in view of MUD-based functionalities, (as taught by Smith and Cowan).

15. Regarding Claims 3, 4, 21-24, 42, 43 and 45, Chelliah, Smith and Cowan are relied upon for those teachings enumerated herein. As noted above, Chelliah teaches a service provider capable of providing incentive program objects, however, Chelliah does not incorporate interactive character icon enhancements (audio/visual - animation and broadcast sound) into the system wherein the enhancement is determined by function activation. Smith and Cowan teach a MUD-based character, with interactive audio/visual enhancement capabilities, whose incorporation into the Chelliah system and method would have been obvious as noted herein above. Thus, Claims 3, 4, 21-24, 42, 43 and 45 are found to be unpatentable over the combined teachings of Chelliah in view of MUD-based functionalities, (as taught by Smith and Cowan).

16. Regarding Claim 5, 25 and 41, Chelliah, Smith and Cowan are relied upon for those teachings enumerated herein. Chelliah further teaches a plurality of subscriber

advertiser nodes, (Col. 31, lines 15-20). Thus, Claims 5, 25 and 41 are found to be unpatentable over the combined teachings of Chelliah in view of MUD-based functionalities, (as taught by Smith and Cowan).

17. Regarding Claims 6-8, Chelliah, Smith and Cowan are relied upon for those teachings enumerated herein. As noted above, Chelliah teaches a service provider capable of providing incentive program objects from a database, (obviously located at the service provider or at the subscriber advertiser), however, Chelliah does not incorporate interactive character icon (and icon enhancements) into the system. Smith and Cowan teach a MUD-based character, with interactive audio/visual enhancement capabilities, whose incorporation into the Chelliah system and method would have been obvious as noted herein above. Thus, Claims 6-8 are found to be unpatentable over the combined teachings of Chelliah in view of MUD-based functionalities, (as taught by Smith and Cowan).

18. Regarding Claims 9, 10, 29, 34 and 38, Chelliah, Smith and Cowan are relied upon for those teachings enumerated herein. As noted above, Chelliah teaches a service provider capable of providing incentive program objects from a database, however, Chelliah does not incorporate interactive character icon (and icon enhancements) into the system, wherein icon enhancement comprises a code represented by a visible icon or discoverable upon performance of an action. Smith and Cowan teach a MUD-based character, with interactive audio/visual enhancement capabilities, whose incorporation into the Chelliah system and method would have been obvious as noted herein above. Thus, Claims 9, 10, 29, 34 and 38 are found to be

unpatentable over the combined teachings of Chelliah in view of MUD-based functionalities, (as taught by Smith and Cowan).

19. Regarding Claims 11, 12, 30 and 35, Chelliah, Smith and Cowan are relied upon for those teachings enumerated herein. As noted above, Chelliah teaches a service provider capable of providing incentive program objects from a database, however, Chelliah does not incorporate interactive character icon (and icon enhancements) into the system, wherein icon enhancement authorization comprises satisfying a condition. Smith and Cowan teach a MUD-based character, with interactive audio/visual enhancement capabilities, whose incorporation into the Chelliah system and method would have been obvious as noted herein above. Thus, Claims 11, 12, 30 and 35 are found to be unpatentable over the combined teachings of Chelliah in view of MUD-based functionalities, (as taught by Smith and Cowan).

20. Regarding Claims 13, 31, 36 and 40, Chelliah, Smith and Cowan are relied upon for those teachings enumerated herein. As noted above, Chelliah teaches a service provider capable of providing incentive program objects from a database, however, Chelliah does not incorporate interactive character icon (and icon enhancements) into the system, wherein icon enhancement authorization comprises satisfying a condition by selecting and entering a correct response to a subscriber advertiser query. Smith and Cowan teach a MUD-based character, with interactive audio/visual enhancement capabilities, whose incorporation into the Chelliah system and method would have been obvious as noted herein above. Thus, Claims 13, 31, 36 and 40 are found to be

unpatentable over the combined teachings of Chelliah in view of MUD-based functionalities, (as taught by Smith and Cowan).

21. Regarding Claim 14, Chelliah, Smith and Cowan are relied upon for those teachings enumerated herein. As noted above, Chelliah teaches a customer information database, (Abstract), however, Chelliah does not incorporate interactive character icon (and icon enhancements) into the system, wherein said character icon and related content represent certain interests and information of the user. Smith and Cowan teach a MUD-based user-created character, with interactive audio/visual enhancement capabilities, whose incorporation into the Chelliah system and method would have been obvious as noted herein above. Thus, Claim 14 is found to be unpatentable over the combined teachings of Chelliah in view of MUD-based functionalities, (as taught by Smith and Cowan).

22. Regarding Claims 15, 16, 32 and 37, Chelliah, Smith and Cowan are relied upon for those teachings enumerated herein. Chelliah further teaches a plurality of subscriber advertiser nodes, (Col. 31, lines 15-20), wherein the routing of a browser program to a second subscriber advertiser upon access of the character icon enhancement authorization, (as noted above) would have been obvious. Thus, Claims 15, 16, 32 and 37 are found to be unpatentable over the combined teachings of Chelliah in view of MUD-based functionalities, (as taught by Smith and Cowan).

23. Regarding Claim 18, Chelliah, Smith and Cowan are relied upon for those teachings enumerated herein. Chelliah further teaches the providing of data wherein the user registers with the service provider operating the service provider server for

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providing user preference information to the service provider, (Abstract). Thus, Claim 18 is found to be unpatentable over the combined teachings of Chelliah in view of MUD-based functionalities, (as taught by Smith and Cowan).

24. Regarding Claim 19, Chelliah, Smith and Cowan are relied upon for those teachings enumerated herein. As noted above, Chelliah teaches a service provider capable of providing incentive program objects from a database, however, Chelliah does not incorporate interactive character icon (and icon enhancements) into the system, wherein icon enhancement comprises accessing a corresponding code. Smith and Cowan teach a MUD-based character, with interactive audio/visual code-based enhancement capabilities, whose incorporation into the Chelliah system and method would have been obvious as noted herein above. Thus, Claim 19 is found to be unpatentable over the combined teachings of Chelliah in view of MUD-based functionalities, (as taught by Smith and Cowan).

25. Regarding Claim 20, Chelliah, Smith and Cowan are relied upon for those teachings enumerated herein. As noted above, Chelliah teaches an interactive system and method for electronic commerce with a service provider capable of providing incentive program objects from a database, however, Chelliah does not incorporate interactive character icon (and icon enhancements) into the system, wherein icon enhancement comprises determining whether a character icon is authorized to access a corresponding enhancement code. Smith and Cowan teach an administratively-controlled MUD-based character system, with interactive audio/visual code-based enhancement capabilities, whose incorporation into the Chelliah system and method

would have been obvious as noted herein above. Thus, Claim 20 is found to be unpatentable over the combined teachings of Chelliah in view of MUD-based functionalities, (as taught by Smith and Cowan).

Conclusion

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent 5,828,843 to Grimm.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arrienne M. Lezak whose telephone number is (703)-305-0717. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (703)-308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Arrienne M. Lezak



DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

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